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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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NORRIS, MCLAUGHLIN & MARCUS			EXAMINER	
875 THIRD AVE			JACOBSON, MICHELE LYNN	
18TH FLOOR				
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/511,332	Applicant(s) FREGONESE ET AL.	
	Examiner Michele Jacobson	Art Unit 1709	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/04, 10/25/04, 11/26/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections/Objections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "cooled below room temperature" but does not distinctly point out what temperature is meant by "room temperature". This lends the claim to being indefinite since it would be impossible to determine what would constitute infringement of the claim.

3. Alternatively, if applicant meant "below room temperature" to mean "below 20° C" (page 4, line 22 of the specification), then claim 9 is duplicative and therefore objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant may choose which interpretation they wish the examiner to adhere to and amend/cancel the claims appropriately.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4, and 54 of copending Application No. 11/234,469 (hereafter referred to as '469). Although the conflicting

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claims are not identical, they are not patentably distinct from each other because the composition of the container recited in '469 is identical to that claimed in the current application. Even though the injection-molded container of '469 differs from the thermoformed film used for the container of the instant application, the method of making the containers is not interpreted to impart any additional functionality. As such claims 4, and 54 of '469 and claims 1-4 of the instant application are product-by-process claims and therefore the processes recited are not limiting.

6. The limitations set forth in claims 1-4 of the instant application are addressed in '469 as follows:

- a. Claim 1 recites a water-soluble container comprising at least one compartment prepared from a film of hydroxy propyl methyl cellulose. Claim 54 of '469 recites a rigid water-soluble container wherein at least one compartment is made at least partly of hydroxy propyl methyl cellulose anticipating claim 1 of the instant application.
- b. Claim 2 recites a container made of hydroxy propyl methyl cellulose that contains a fabric or surface care or dishwashing composition in a compartment. Claim 4 of '469 recites a water-soluble container made of at least two water-soluble polymers, a first polymer comprising a cellulose derivative (such as hydroxy propyl methyl cellulose, see claim 54) and a second water-soluble polymer that is "active in detergency" when dissolved. The definition of detergency according to the Merriam-Webster dictionary is something having a "cleansing quality or power". Since a polymer that is active in detergency could

be used to clean fabric, surfaces or dishes, the examiner interprets the second water-soluble polymer that is "active in detergency" to fall within the boundaries of fabric or surface care or dishwashing compositions. If the hydroxy propyl methyl cellulose layer is disposed on the outside of the container and the detergency active polymer is on the inside then the composition of the article produced is not patentably distinct from that claimed in claim 2 of the instant application.

c. Claim 3 recites a container made from a laminated water-soluble film with at least one layer of hydroxy propyl methyl cellulose. Claim 4 of '469 recites a water-soluble container made of at least two water-soluble polymers, a first polymer comprising a cellulose derivative (such as hydroxy propyl methyl cellulose, see claim 54). Since the container of '469 is comprised of two layers (therefore meeting the limitation of being laminated) one of which being hydroxy propyl methyl cellulose, the invention as claimed in claim 3 is not patentably distinct.

d. Claim 4 recites a thickness for the hydroxy propyl methyl cellulose film used to form the container. While none of the claims in '469 directly address the thickness of the container formed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the film thickness to achieve the desired rates of dissolution and to impart the appropriate structural integrity to the article.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hammond WO 02/16206 A1 (hereafter referred to as Hammond).

9. Hammond teaches “A process for producing an inflated, water-soluble container which comprises: a) forming an open container from a water-soluble film ... c) sealing the container”. (Claim 1) Claims 4 and 5 further limit the process of claim 1 by reciting that step “a) comprises thermoforming the film to produce a pocket” (Claim 4) and that step c) comprises “placing a second water-soluble film on top of the filled pocket and sealing the films together”. (Claim 5) A suitable water-soluble film to form the container is recited to be hydroxy propyl methyl cellulose. (Page 5, lines 15-17) The thickness of the water-soluble film is recited to be between 20 and 500 µm.

10. Hammond clearly anticipates the “water-soluble container comprising at least one compartment prepared from a thermoformed film of hydroxy propyl methyl cellulose” recited in claim 1.

11. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ciallella U.S. Patent No. 4,806,261 (Hereafter referred to as Ciallella).

12. Ciallella teaches an article which "comprises a particulate built synthetic organic detergent composition in a closed container, the walls of which container are composed of a readily water dispersible sheet or film of water soluble cellulose compound and cellulose fibers" laminated with a water soluble polyvinyl alcohol on the interior surface. (Claim 1) A compound that may be used for the water-soluble cellulose component is recited to be hydro-propyl methyl cellulose, which corresponds to applicant's recitation of hydroxy propyl methyl cellulose. (Col. 5, line 7) The thickness of the wall of the container in Ciallella is recited to be in the range of 50-300 μm . (Col. 12, lines 29-30)

13. Ciallella clearly anticipates all the limitations of a water-soluble container comprising at least one compartment made of hydroxy propyl methyl cellulose that has been laminated and is between 40-300 μm thick containing a fabric care composition as set forth in claims 1-4. The limitation of the container being produced by thermoforming does not appear to impart any special functionality to the product claimed and is therefore a product-by-process limitation. (See MPEP 2113) The product of Ciallella is the same as that recited by applicant and as such Ciallella clearly anticipates applicant's invention.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond WO 02/16206 A1 (hereafter referred to as Hammond).

16. Hammond teaches "A process for producing an inflated, water-soluble container which comprises: a) forming an open container from a water-soluble film ... c) sealing the container". (Claim 1) Claims 4 and 5 further limit the process of claim 1 by reciting that step "a) comprises thermoforming the film to produce a pocket" (Claim 4) and that step c) comprises "placing a second water-soluble film on top of the filled pocket and sealing the films together". (Claim 5) A suitable water-soluble film to form the container is recited to be hydroxy propyl methyl cellulose. (Page 5, lines 15-17) The thickness of the water-soluble film is recited to be between 20 and 500 μm .

17. Hammond is silent regarding the temperatures and duration of heating of the water-soluble film and the temperature of the mold used.

18. Hammond recites all the elements of the method of claims 5-9 except heating the hydroxy propyl methyl cellulose film to 120-140° C for 1-10 s and cooling the molds used. There appears to be no criticality to the range as stated since the applicant's specification does not recite any unexpected result. (See page 4, lines 17-20, pages 23-

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24) Additionally, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the temperature and duration of heating of the film in concert with optimizing the temperature of the mold used in order to facilitate molding and prevent melting of the film.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Jacobson whose telephone number is (571) 272-8905. The examiner can normally be reached on Monday-Friday 7:30 AM-5 PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michele L. Jacobson
Examiner
Art Unit 1709


D. LAWRENCE TARAZANO
PRIMARY EXAMINER